UNITED STATES PATENT AND TRADEMARK OFFICE

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10/065,527	10/25/2002	Carl Michael Dennison	BLD920010034US2	2144

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NOTIFICATION DATE	DELIVERY MODE
08/16/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *14 June 2010*.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-20* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 6/14/10 have been fully considered but they are not

persuasive.

The Applicant argues on page 10 of the response in essence that:

The system of Livingston '454 is not invoked by viewing the document, and does not

disclose opening a document viewing application.

a.   Livingston '454 discloses displaying a graphical user interface for setting

printer options (Figs. 3A and B, col. 1-2, lines 56-67, 1-10). In response to

applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e.,

invoking the system by viewing the document) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues on page 11 of the response in essence that:

Livingston '454 and Lahey '945 fail to disclose interactions otherwise modifying the

document.

b.   Livingston '454 discloses that when a user selects "Staple this Job Using"

in Fig. 3A, the print preview image 68 shows the selected page as it will appear

when it is printed (col. 5, lines 6-53).

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

4.   Claim 1 recites "interactions with said displayed document creating an amended

document file", and "any changes to said print job ticketing parameters made by said

interactions being included in a print job ticket for the amended document." The

Applicant's original disclosure fails to describe that interactions create an amended

document file, or that a print job ticket includes changes to print job ticketing parameters

made by said interactions. The Applicant's original disclosure on page 4, paragraph 14

states that "When the document is to be saved or printed, the plug-ins search each

page for visual cue objects and remove them, so that the saved or printed document

does not include the cues." The visual cues are never stored (i.e. saved) within the

document because they are removed prior to saving. Therefore, the Applicant's original

disclosure does not describe interactions with said displayed document creating an

amended document file. Claim 9 includes similar limitations.

5.   Claim 2 recites "wherein the specific operation is a save operation saving said print job ticket to storage for subsequent forwarding to print." The Applicant's original disclosure fails to describe that print job ticketing parameters are included in a print job ticket (as recited in claim 1) responsive to saving said print job ticket to storage. Claim 10 includes similar limitations.

6.   Claim 3 recites "said print job ticket being created responsive to initiating." The Applicant's original disclosure fails to describe that a print job ticket is created in response to initiating a print. Claim 11 includes similar limitations.

7.   Claim 4 recites "wherein said step of removing said visual feedback further includes locating and removing markers in said file." The Applicant's original disclosure fails to describe locating and removing markers in said file. Claim 12 includes similar limitations.

8.   Claim 5 includes limitations for inserting visual cue objects in said file and removing visual cue objects from said file. The Applicant's original disclosure fails to describe inserting or removing visual cue objects from a file. Claim 13 includes similar limitations.

9.   Claim 6 recites "said print job ticket is created when the markers are removed" and "opening said original document comprises installing at least one plug-in to said document editor." The Applicant's original disclosure fails to describe creating a print job ticket when markers are removed, or installing a plug-in when opening said original document. Claim 14 includes similar limitations.

10.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

11.   Claim1-20 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 includes references to "the displayed document" on lines 8, 12 and 20. It

is unclear whether "the displayed document" corresponds to "the original document" or

"the amended document." Claim 9 contains similar limitations.

Claim Rejections - 35 USC § 101

12.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

13.   Claims 9-16, 19 and 20 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Claim 9 is directed to data structures embodied on a computer readable medium.

The broadest reasonable interpretation of a claim drawn to a computer readable

medium includes forms of non-transitory tangible media and transitory propagating

signals *per se* in view of the ordinary and customary meaning of computer readable

media. *See Subject Matter Eligibility of Computer Readable Medium*, Jan. 26, 2010.

The Applicant's specification does not limit computer-readable medium to non-transitory

embodiments, and therefore claims 9-16, 19 and 20 are non-statutory. The Examiner

suggests amending the claims to include "non-transitory computer readable medium" or

similar language.

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

15.   Claims 1-5 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Livingston Patent 6,614,454, and further in view of Lahey Patent 5,999,945.

Referring to claims **1 and 9**, Livingston '454 discloses a method comprising:

opening a document viewing application (Figs. 3A and B, col. 1-2, lines 56-67, 1-

10);

opening an original document in said document viewing application, said original

document being in a file in memory (col. 2, lines 11-36, the computer implemented

printer control system includes memory configured to provide an operating system and

operative to store files representing at least one document to be printed);

displaying said original document (col. 5, lines 38-53, print preview image 68 of

Fig. 3A shows placement of the three staples 69);

inserting into the original document display a plurality of visual cue objects

corresponding to print job parameters in said original document, the displayed

document indicating application of said print job parameters to said original document

(col. 5, lines 38-53, print preview image 68 of Fig. 3A shows placement of the three

staples 69);

inserting visual feedback into the original document, said visual feedback being

responsive to interactions with said displayed document and being indicated by

changes to displayed visual cue objects, interactions with said displayed document

creating an amended document file (col. 5, lines 6-53, when a user selects "Staple this

Job Using" in Fig. 3A, the print preview image 68 shows the selected page as it will

appear when it is printed);

removing said visual feedback from the amended document (col. 5, lines 6-27,

when a user deselects "Staple this Job Using" in Fig. 3A, the staples displayed on print

preview image 68 will be removed), any changes to said print job parameters made by

said interactions being included in a print job settings for the amended document, said

visual feedback being removed responsive to performing the specific operations (col. 5,

lines 38-53, the print preview image 68 shows the selected image as it will appear when

it is printed [i.e. selected print settings are applied to the printed document]).

Livingston '454 does not disclose expressly printing the amended document

responsive to a print job ticket.

Lahey '945 discloses print job ticketing parameters (col. 5, lines 46-50, the job

ticket maintains information on print attributes of the print job);

forwarding said document and said print job ticket to a printer (col. 8-9 lines 61-

67, 1-13, the user can submit the job ticket to the InfoPrint MPC server 6 for printing);

and

printing said amended document responsive said print job ticket (col. 5, lines 46-50, the job ticket maintains information on print attributes and the location of the print files which comprise the print jobs).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize a job ticket to store print settings. The motivation for doing so would have been to efficiently store print settings in a widely used format. Therefore, it would have been obvious to combine Lahey '945 with Livingston '454 to obtain the invention as specified in claims 1 and 9.

Referring to claims **2 and 10**, Lahey '945 discloses wherein the specific operation is a save operation saving said print job ticket to storage for subsequent forwarding to print (col. 9, lines 14-17, once the user creates a job ticket, the user may save the job ticket 40).

Referring to claims **3 and 11**, Livingston '454 discloses wherein the specific operation is initiating a print ("Print" of Fig. 3A, col. 5, lines 17-20).

Lahey '945 discloses said print job being created responsive to initiating (col. 8-9 lines 61-67, 1-13, the user can submit the job ticket to the InfoPrint MPC server 6 for printing).

Referring to claims **4 and 12**, Livingston '454 discloses wherein said step of inserting visual cues objects into the displayed document further includes inserting a marker to each of the plurality of visual cue objects, each said marker not being displayed, and wherein said step of removing said visual feedback further includes locating and removing markers in said file (col. 5, lines 38-53, print preview image 68 of

Fig. 3A shows placement of the three staples 69 [It is inherent that the program of

Livingston needs to track of whether the option for staples has been selected or not. A

register or variable present in the program code indicates the selection of the user and

is and unseen marker. The selection or deselection of the "Staple this Job Using"

button would require locating the register or variable to record the result.]).

Referring to claims **5 and 13**, Livingston '454 discloses wherein said step of

inserting visual cues objects into the displayed document further includes maintaining a

list of markers to each of the plurality of visual cue objects inserted in said file (col. 5,

lines 20-27, as is shown in Fig. 3A of Livingston, the option of stapling is provided

sequentially is a list format. The user is able to visible view the list and determine which

staples that are desired to be removed) and wherein said step of removing said visual

feedback further includes referencing the list and identifying the markers to the plurality

of visual cue objects to be removed from said file (col. 5, lines 6-27, when a user

deselects "Staple this Job Using" in Fig. 3A, the staples displayed on print preview

image 68 will be removed).

16.   Claims 6-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Livingston Patent 6,614,454 and Lahey Patent 5,999,945 as applied to claims 1

and 9 above, and further in view of Simpson Publication 2002/0184305.

Referring to claims **6 and 14**, Livingston '454 discloses wherein said document

viewing application is a document editor and the steps of inserting and removing are

performed, but does not disclose expressly the steps being performed by a plug-in to a document editor.

Simpson '305 discloses plug-in to a document editor providing a plug-in interface (page 1, paragraph 3).

At the time of the invention, it would have been obvious for a person of ordinary skill in the art to apply the print preview program of Livingston as a plug-in to a document editor. The motivation for doing so would have been to increase the flexibility of a program by allowing its incorporation into other programs. Therefore, it would have been obvious to combine Simpson '305 with Livingston '454 to obtain the invention as specified in claims 6 and 14.

Referring to claims **7 and 15**, Livingston '454 discloses applying certain of the print job ticketing parameters to all pages of the document file responsive to said interactions ("Apply changes to: All Pages" of Fig. 3B).

Referring to claims **8 and 16**, Livingston '454 discloses applying certain of the print job ticketing parameters to selected pages of the document file responsive to said interactions ("Apply changes to: All Pages" of Fig. 3B, The changes are shown to apply to selecting all pages).

17.	Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston Patent 6,614,454 and Lahey Patent 5,999,945 as applied to claims 1 and 9 above, and further in view of Koppolu Patent 6,268,924.

Referring to claims **17 and 19**, Livingston '454 discloses wherein said step of inserting visual cue objects into the displayed document further includes displaying the plurality of visual cue objects, but does not disclose expressly the print preview being a thumbnail.

Koppolu '924 discloses a print preview being a thumbnail (col. 6, lines 27-37).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard format well known in the art. Therefore, it would have been obvious to combine Koppolu et al. with Livingston '454 to obtain the invention as specified in claims 17 and 19.

18.   Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston Patent 6,614,454, Lahey Patent 5,999,945 and Simpson Publication 2002/0184305 as applied to claims 6 and 19 above, and further in view of Koppolu Patent 6,268,924.

Referring to claims **18 and 20**, Livingston '454 discloses wherein said step of inserting visual cue objects into the displayed document further includes displaying the plurality of visual cue objects, and monitoring the print preview for the current page selection (col. 5, lines 39-44).

Simpson '305 discloses a plug-in to a document editor providing a plug-in interface (page 1, paragraph 3).

Livingston '454 does not disclose expressly the print preview being a thumbnail.

Koppolu '924 discloses a print preview being a thumbnail (col. 6, lines 27-37).

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for

doing so would have been to utilize a space saving image format. Further, a thumbnail

file is standard format well known in the art. Therefore, it would have been obvious to

combine Koppolu '924 with Livingston '454 and Simpson '305 to obtain the invention as

specified in claims 18 and 20.

Conclusion

19.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625